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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/872,451

05/31/2001

Robert Lennie

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7590

07/26/2006

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EXAMINER

SIDDIQI, MOHAMMAD A

ART UNIT

PAPER NUMBER

2154

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/872,451	<b>Applicant(s)</b> LENNIE ET AL.	
	<b>Examiner</b> Mohammad A. Siddiqi	<b>Art Unit</b> 2154	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 May 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 and 30-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 and 30-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-28 and 30-33 are presented for examination. Claim 29 has been cancelled.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-28 and 30-33 rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. (6,850,757) (hereinafter Watanabe) in view of Mousseau et al. (US PUB 2002/0120696) (hereinafter Mousseau).

4. As per claims 1 and 27, Watanabe discloses A communication system and method comprising: a mail server 102, fig 1), coupled to the Internet (104, fig 1) for storing an electronic mail message received over the Internet and for generating a copy of said electronic mail message (Fig 1, col 2, lines 24-46);

a notifications server (col 2, lines 24-36), coupled to said mail server (col 2, lines 24-36),

wherein said notifications server (col 2, lines 24-60) is for automatically generating (col 2, lines 24-60), therefrom, a subset of said received copy of said electronic mail message (col 5, lines 6-31); and

wherein said notifications server (col 2, lines 24-60), upon generation of said subset (col 5, lines 6-31), is for wirelessly transmitting (col 1, lines 5-10) said subset (col 3, lines 33-35) to an identified wireless electronic device (col 5, lines 6-31) associated with a user that is the recipient of said received electronic mail message (cellular phone, col 5, lines 6-39).

Watanabe is silent about having a standard electronic mail protocol for receiving said copy of said electronic mail message as a standard formatted electronic mail messages. However, *Simple Mail Transfer*, a protocol for sending e-mail messages between servers; Most e-mail systems that send mail over the Internet use SMTP to send messages from one server to another; the messages can then be retrieved with an e-mail client using either POP or IMAP; In addition, SMTP is generally used to send messages from a mail client to a mail server; SMTP, POP, or IMAP e-mail server are known in the art. For example, Mousseau discloses having a standard electronic mail protocol for receiving said copy of said electronic mail message as a standard formatted electronic mail messages. (page 6,

paragraph #0062; page 9, paragraph 0084). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Watanabe and Mousseau. The motivation would have been developing system for pushing/notifying from a host system to user's mobile device based on the user-defined events.

5. As per claim 14, the claim is rejected for the same reasons as claim 1, above. In addition, Watanabe discloses a plurality of wireless electronic devices operable to communicate over a wireless communication network (106, fig 1, col 2, lines 24-60).

6. As per claims 2, 15, and 28, claims are rejected for the same reasons as claim 1, above. In addition, Watanabe discloses said identified wireless electronic device is operable to display received subsets to a user LCD display, (col 5, lines 29-31).

7. As per claims 3, and 16, claims are rejected for the same reasons as claim 1, above. In addition, Watanabe discloses said identified wireless electronic device is operable to allow said user to select a particular received subset and wherein said notifications server is also for transmitting the remainder of an electronic mail message corresponding to said particular

received subset in response to the selection thereof by said identified wireless electronic device (col 5, lines 45-67; col 6, lines 18-43).

8. As per claims 4 and 17, claims are rejected for the same reasons as claim 1, above. In addition Mousseau discloses said subset is a notification message comprising a sender's identification and a subject field of said received electronic mail message (page 8, paragraph #0076).

9. As per claims 5 and 18, claims are rejected for the same reasons as claim 1, above. In addition, Watanabe discloses said identified wireless electronic device is a handheld computer system having wirelessly enabled (fig 3, col 3, lines 28-36).

10. As per claims 6, 19, and 31, claims are rejected for the same reasons as claim 1, above. In addition, Watanabe discloses wherein said notifications server comprises a user information database for providing a mapping between wireless electronic devices and their associated electronic mail addresses (fig 3, col 3, lines 28-36).

11. As per claims 7, 20 and 32, claims are rejected for the same reasons as claim 1, above. In addition, Watanabe discloses a push packet (is used

by said notifications server to wirelessly transmit said subset to said identified wireless electronic device (col 5, lines 22-28).

12. As per claims 8 and 21, claims are rejected for the same reasons as claim 1, above. In addition, Watanabe discloses said subset is wirelessly transmitted using a wireless LAN communication network (elements of fig 1).

13. As per claims 9 and 22, claims are rejected for the same reasons as claim 1, above. In addition Mousseau discloses, using a Bluetooth wireless communication network (page 22, paragraph #0174).

14. As per claims 10 and 23, claims are rejected for the same reasons as claim 1, above. In addition Mousseau discloses using a Mobitex wireless communication network (page 21, paragraph #0164).

15. As per claims 11, 24, and 33, claims are rejected for the same reasons as claim 1, above. In addition Mousseau discloses said standard electronic mail protocol is substantially compliant with the SMTP protocol (page 9, paragraph #0084).

16. As per claims 12 and 25, claims are rejected for the same reasons as claim 1, above. In addition Mousseau discloses POP protocol (page 9, paragraph #0084).

17. As per claims 13 and 26, claims are rejected for the same reasons as claim 1, above. In addition Mousseau discloses IMAP protocol (page 9, paragraph #0084).

18. As per claim 30, claims are rejected for the same reasons as claim 1, above. In addition, Watanabe discloses said identified wireless electronic device allowing said user to select a particular received notification message (col 5, lines 45-67; col 6, lines 18-43); and

said notifications server transmitting the remainder of an electronic mail message corresponding to said particular received notification message in response to said user selecting said particular received notification message (col 5, lines 45-67; col 6, lines 18-43).



***Response to Arguments***

19. Applicant's arguments filed 05/12/2006 have been fully considered but they are not persuasive, therefore rejections to claims 1-28 and 30-33 is maintained.

20. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re*

*Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Watanabe is silent about having a standard electronic mail protocol for receiving said copy of said electronic mail message as a standard formatted electronic mail messages. However, ***Simple Mail Transfer***, a protocol for sending e-mail messages between servers; Most e-mail systems that send mail over the Internet use SMTP to send messages from one server to another; the messages can then be retrieved with an e-mail client using either POP or IMAP; In addition, SMTP is generally used to send messages from a mail client to a mail server; SMTP, POP, or IMAP e-mail server are known in the art. For example, Mousseau discloses having a standard electronic mail protocol for receiving said copy of said electronic mail message as a standard formatted electronic mail messages. (page 6, paragraph #0062; page 9, paragraph 0084). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Watanabe and Mousseau. The motivation (Watanabe, col 1, lines 39-44, mail notification) would have been developing system for pushing/notifying from a host system to user's mobile device based on the user-defined events.

***Conclusion***

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

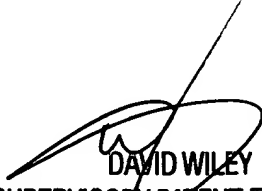
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A. Siddiqi whose telephone number is (571) 272-3976. The examiner can normally be reached on Monday -Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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